

Remarks

The specification and claims 1, 3, 10, 16, 28, 38 and 40 have been amended. Claim 15 has been canceled and new claims 41-50 have been added. Review and reconsideration in light of the amendments and the remarks below are requested.

The final Office action of August 26, 2005 objects to the specification for failing to provide proper antecedent basis for the subject matter of claim 8. Accordingly, the specification has been amended to explicitly mention the binding means. It is submitted that this amendment does not add any new matter since claim 8, as originally filed, discloses a binding means. Thus it is submitted that the objection to the specification has been overcome.

Claims 38 and 40 have been amended to address the 35 U.S.C. §112 rejection thereto. Claim 10 has been amended to correct a typographical error.

Claims 1-8, 10-14, 28 and 29 are rejected as defining obvious subject matter over Great Britain Patent No. 2,289,520 in light of U.S. Pat. No. 1,906,261 to Glass. Claims 2, 9, 15 and 16 are rejected as defining obvious subject matter of the Great Britain reference, in light of Glass, and further in view of U.S. Pat. No. 5,997,995 to Scianna, or further in view of U.S. Pat. No. 4,454,058 to Savit, or further in view of alleged admitted prior art. Claim 15 has been amended to generally include the subject matter of claim 15. Thus, to the extent the rejection of claim 15 would be carried over to claim 1, the rejection is respectfully traversed for the reasons outlined below.

The Office action cites to column 3, lines 1-6 of the Scianna reference as allegedly disclosing the idea of adding a dielectric to a mouse pad, and therefore the desirability of reducing static on mouse pads. However, Applicants submit that the Scianna reference only discloses the desirability of adding a dielectric to the bottom of a mouse pad. In particular, column 3, lines 1-6 of the Scianna reference discloses that a dielectric material is added to an ink formulation. At column 2, lines 63-66 of Scianna it is disclosed that the ink is part of a thin film or coating 12. As can be seen in Fig. 2, the coating 12 is located on the bottom of the thermoplastic pad or mat 10. At column 3, lines 17-18 of Scianna it is also noted that the non-slip surface (which includes the ink formulation and the dielectric material) is applied to the underside of the pad or mat. As disclosed at column 3, lines 7-11 and column 12, line 65, the ink

formulation of Scianna provides a tackiness characteristic to provide a non-slip feature to the bottom of the pad or mat.

Thus, to the extent the Scianna reference discloses the use of a dielectric material with a mouse pad, it teaches the application of such dielectric material to the bottom of the support pad of the mouse pad as a tacky gripping surface on the underside of the pad. The Scianna reference does not appear to disclose the use of a dielectric on the upper surface of each sheet. Thus, if the teachings of the Scianna reference were to be combined with the Great Britain and Glass references, the result would be a tacky, dielectric ink applied to the bottom synthetic rubber pad 3 of the Great Britain reference. However, claim 1 specifies that an upper surface of each sheet is treated to have an anti-static electric property or a reduced static electricity charge. Thus it is submitted that the subject matter of claim 1 would not be shown, even if the Great Britain, Glass and Scianna references were to be combined.

At page 3, lines 16-21 of this application, it is noted that the anti-static properties or low static electricity charge reduces dust accumulation and reduces interference with the electrical components of a mouse. If the sheets of the mouse pad did not include the anti-static properties or low static electricity charge, a mouse used with the mouse pad could eventually function in a faulty manner, or even fail. Accordingly it is submitted that claim 1 defines over the cited references. Independent claim 28 is submitted to be allowable for the same or similar reasons as claim 1.

The Savit reference is directed to technology for use in printing operations, and discloses that a coating may be used to increase conductivity. An increase in conductivity is apparently known to provide improved performance in dielectric copying and printing. In particular, improved conductivity apparently allows a through-current to pass through the sheet to improve certain printing operations (column 1, lines 20-23). However, the Savit reference does not include any reference to or discussion of mouse pads, and instead appears to be limited to use with substrates utilized in dielectric printing and copying. Thus it is submitted that there is not sufficient teaching or motivation to use the teachings of the Savit reference on the sheets of the mouse pad of the Great Britain reference.

Similarly, page 11, lines 4-12 of Applicant's amendment of November 19, 2004 merely provides a listing of patents which disclose anti-static coatings or treatments. None of these

patents disclose the use of anti-static coatings or treatments for use with a mouse pad. It is submitted that a proper obviousness rejection is not made out by simply showing anti static coatings on the one hand, and a mouse pad calendar on the other, and then proposing to combine the two technologies. Instead, as is well known “[T]here must be a showing of a suggestion or motivation to modify the teaching of the reference.... Whether the Board relies upon an express or an implicit showing, it must provide particular findings thereto [citation omitted]. Broad conclusory statements standing alone are not ‘evidence’” *In re Kotzab* 55 USPQ (BNA) 2d 1313, 1317 (Fed. Cir. 2000).

In addition, the Scianna reference, as applied to the Savit reference and the allegedly admitted prior art, actually teaches against the combination proposed in the Office action. As outlined above, the Scianna reference discloses the use of a dielectric-impregnated ink on the bottom surface of a mouse pad. Thus, if the cited art were to be combined in the manner proposed, the claimed subject matter would not be shown.

It is also submitted that Applicant's statement at page 11, lines 4-12 of the Amendment of November 19, 2004 is not an admission of prior art. Instead, that passage merely lists various patents, which may qualify as prior art assuming the applicable standards under 35 U.S.C. §102 are met. The passage does state that the invention is not directed to "new" anti-static coatings, but does not include any admission as to what may constitute "old" or prior art coatings.

New independent claims 44 and 48 specify that each sheet is not directly joined to any adjacent sheet at an intermediate location of each edge of each sheet such that a user can slide a finger between adjacent ones of the sheet at the intermediate location along each edge. In contrast the Great Britain patent discloses an adhesive extending along the entire length of three outer edges thereof (see Fig. 5). The claimed pattern of adhesive allows greater flexibility to the user in the manner in which the topmost sheet can be removed. In particular, the mouse pad can be arranged in nearly any configuration and still allow a user an immediate access point to remove the top-most sheet.

In contrast, in the Great Britain patent a user may need to manually feel along three edges of the mouse pad before finding the access point for tearing. After unsuccessfully feeling along two or three edges a user may become frustrated and attempt to remove the top-most sheet along an adhered edge, which can inadvertently cause more than one sheet to be removed. If the sheets

are arranged in chronological order, as proposed in the Office action, the removal of more than one sheet can defeat the functionality of the mouse pad. Thus it is submitted that the subject matter of claims 44 and 48 provides a definite advantage over the device of the Great Britain patent, and distinguishes over the cited references.

It is also noted that the final Office action discusses the Declaration submitted with Applicant's amendment of June 22, 2005. In that Declaration it was noted that since the introduction of the mouse pad calendar in 2002 MeadWestvaco has sold 468,484 units and derived \$1,474,922 in gross revenue, and that sales have shown a steady increase since the mouse pad's introduction. The Declaration also notes that major retailers such as Wal-Mart, K-Mart, Office Max, Staples, Office Depot, Safeway, and Carlton Cards have purchased the mouse pad calendars from MeadWestvaco for sale to others.

The Office action takes the position that the Applicant has failed to show that the claimed features are responsible for the commercial success of the calendars. However, the Declaration noted that the commercial success of the invention has been achieved without great advertising expenditures, and that MeadWestvaco does not generally market the mouse pad calendar to the general public and does not generally directly market the mouse pad calendar to its retail customers.

It is submitted that this evidence is probative of the fact that high advertising expenditures are not responsible for the commercial success of the invention. Thus it is submitted that the commercial success of the invention provides secondary indicia of non-obviousness. As noted at MPEP §716.03, the nexus between the claimed invention and the evidence of commercial success only requires a factually and legally sufficient connection between the commercial success and the invention such that the evidence is of "probative value" in the determination of nonobviousness. It is submitted that Applicant's evidence in this regard provides sufficient probative value.

As noted above, Applicant has provided evidence that high advertising expenditures are not responsible for the commercial success. However, it is submitted that the motivation behind each buyer's purchase (i.e., showing that the claimed features are reasonable for commercial success) cannot be ascertained without direct communication with each buyer. Indeed, MPEP §716.03 (citing a civil litigation case) notes that "A requirement for proof of the negative of all

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imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence." It is further submitted that the only practical way in which it can be shown that the claimed features are responsible for commercial success is through indirect evidence, such as that provided in the Declaration. Thus it is submitted that Applicant's evidence of commercial success retains merit and is probative of the non-obviousness of the invention.

Therefore it is submitted that the application is in a condition for allowance, and a formal notice thereof is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



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